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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/834,112	04/12/2001	Rick Allen Hamilton II	AUS920010173US1	3424

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IBM CORPORATION (RHF)  
C/O ROBERT H. FRANTZ  
P. O. BOX 23324  
OKLAHOMA CITY, OK 73123

EXAMINER

THEIN, MARIA TERESA T

ART UNIT

PAPER NUMBER

3627

DATE MAILED: 04/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/834,112

Applicant(s)

HAMILTON ET AL.

Examiner

Marissa Thein

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

Applicants' "Response to Office Action Under 37 CFR 1.111 and Amendment under 37 CFR 1.121" has been considered.

Applicants' response to claim 1 has overcome the Examiner's rejection of such claim under 35 USC § 112, second paragraph.

Applicants' response to claim 9 has not overcome the Examiner's rejection of such claim under 35 USC § 112, second paragraph.

Claims 1-2, 4-6, 8-10, and 12 are amended. Claims 1-12 remain pending in this application.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-12 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The recitations in claim 1: "which are not

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associated with a physical merchant facility”, “wherein said physical merchant facility is actually nonexistent” and “such merchant facility is actually nonexistent”; and in claims 5 and 9: “which no physical retail facility exists”, and “wherein the physical retail facility is nonexistent” are not described in the specification. The specification does disclose “online-only retailers” in page 4, line 16, which does not define a physical merchant facility is nonexistent because retailers and merchants store their inventory or products in a facility. For example, Amazon is an “online-only retailer” however, its products are stored in a warehouse which is a physical facility.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Regarding claims 1-12, the recitations in claim 1: “which are not associated with a physical merchant facility”, “wherein said physical merchant facility is actually nonexistent” and “such merchant facility is actually nonexistent”; and in claims 5 and 9: “which no physical retail facility exists”, and “wherein the physical retail facility is nonexistent” are unclear because there is no description in the specification.

Regarding claims 5 and 9, the recitation “such that an apparent relationship between an existent physical retail facility and said cyberstore is provided to said user wherein the physical retail facility is nonexistent” is unclear and vague. Does the facility

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exist or not? The Examiner will interpret the claim as having a nonexistent physical retail facility.

Regarding claim 9, the claim recites "a shopping mall browser" which comprises a number of functionalities, it is unclear how "a mall browser" can encompass display and presenting as well as initializing and tracking functionalities.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,388,688 to Schileru-Key.**

Regarding claims 1 and 5, Schileru-Key discloses a method and a computer readable medium of presenting information regarding products, supplier and offerors to users of a browsing device visiting a cybermall (interactive navigation and exploration of spatial environments, both real and virtual, col. 1, lines 55-57; virtual shopping mall and virtual stores, col. 12, lines 60-61), the cybermall comprising a collection of cyber stores (virtual shopping mall and virtual stores, col. 12, lines 60-61), the method and computer readable medium comprising the steps of:

- displaying or provide to a user a portion of a computer display a map of a cybermall, the map having a coordinate system associated with positions within

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the cybermall (a map view window is initialized with intersections, paths; col. 5, lines 15-22; Figure 1 ref. no. 106 map; Figure 13 and Figure 15);

- assigning a user an initial position having a set of coordinates within the cybermall (main view window 1110 shows the image frame associated with the starting intersection, as well as any path choices 1130 col. 5, lines 19-21; when the user selects a choice, the path represented by that choice and any destination intersections are highlighted in map view window, col. 5, lines 23-26);
- presenting to the user at least one vector graphics multimedia object to the user according to the initial position coordinates, the multimedia objects being associated with one or more cyberstores such that an apparent relationship to an existent physical merchant facility is provided (col. 5, lines 23-35; col. 8, lines 36-50; Figure 12);
- updating the initial position to a subsequent position responsive to a position change command from the user (when the user selects a choice, the path represented by that choice and any destination intersections are highlighted in map view window. The program plays the image sequence associated with the path, col. 5, lines 23-27); and
- presenting to the user at least one multimedia object to a customer indexed to the subsequent position, thereby providing the appearance to the user of movement through an existent merchant facility (Figure 18; col. 5, lines 26-35).

However, Schileru-Key does not explicitly disclose the physical merchant facility is actually nonexistent. The differences are only found in the nonfunctional descriptive

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material and are not functionally involved in the steps recited. The steps of displaying, assigning, presenting, and updating would be performed regardless of the facility being nonexistent. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 f.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Furthermore, merchants or retailers being an “online-only retailer” or “brick and mortar” will always need physical facilities in order to store their inventory and products. Thus, it would be impossible for merchants or retailers not to have a physical facility.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Schileru-Key to include the nonexistent physical merchant facility because such nonexistent physical merchant facility does not functionally relate to the steps in the method claimed and because the subjective interpretation of the facility does not patentably distinguish the claimed invention.

Regarding claims 2-4, 6-8 and 10-12, Schileru-Key discloses presenting a visual image of a simulated mall or simulated store interior (virtual shopping mall and virtual stores, col. 12, lines 60-61; replicates a real life shopping experience; col. 12, lines 65-66); providing a customer-selectable hot spot (HotSpot) within the visual image (col. 5, lines 6-8; col. 5, lines 23-30); updating the customer’s position responsive to selection of the hot spot (col. 5, lines 27-35); and presenting a sound clip (audio clip) representative

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of simulated background sound within a mall or store interior (col. 4, lines 23-25; col. 5, lines 3-5; col. 5, lines 27-30).

Regarding claim 9, Schileru-Key discloses a shopping mall browser comprising: a mall map display on a portion of a web browser for shopping a user a virtual geographical organization of a cybermall contents, the map having a coordinate system associated with positions within the cybermall, the cybermall comprising a collection of cyberstores, each cyberstores representing an online-only merchant for which no physical retail facility exists (a map view window is initialized with intersections, paths; col. 5, lines 15-22; Figure 1 ref. no. 106 map; Figure 13 and Figure 15); a user position initializer for assigning an initial set of coordinates within the cybermall (main view window 1110 shows the image frame associated with the starting intersection, a swell as any path choices 1130 col. 5, lines 19-21; when the user selects a choice, the path represented by that choice and any destination intersections are highlighted in map view window, col. 5, lines 23-26); a position tracker for updating the initial position to a subsequent position responsive to a position change commend from the user (when the user selects a choice, the path represented by that choice and any destination intersections are highlighted in map view window. The program plays the image sequence associated with the path, col. 5, lines 23-27); and a multimedia object presenter for presenting to the user on the web browser at least one multimedia object including at least one vector graphics image of a cyberstore indexed to the initial position or the subsequent position such that an apparent relationship between a



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physical retail facility and the cyberstore is provided (col. 5, lines 23-35; col. 8, lines 36-50; Figure 12; Figure 18).

However, Schileru-Key does not explicitly disclose no physical retail facility exists and the physical merchant facility is actually nonexistent. The differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The steps of displaying, assigning, presenting, and updating would be performed regardless of the facility being nonexistent. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Furthermore, merchants or retailers being an "online-only retailer" or "brick and mortar" will always need physical facilities in order to store their inventory and products. Thus, it would be impossible for merchants or retailers not to have a physical facility.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Schileru-Key to include the nonexistent physical merchant facility because such nonexistent physical merchant facility does not functionally relate to the steps in the method claimed and because the subjective interpretation of the facility does not patentably distinguish the claimed invention.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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U.S. Patent Application Publication No. 2001/0056377 to Kondoh et al. discloses a set-up of shops and a shopping method in a cyber mall on the Internet.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marissa Thein whose telephone number is <sup>(571) 272-6764</sup> ~~703-305-~~

*ju*  
4/15/05

~~5246~~. The examiner can normally be reached on M-F 8:00-5:00.

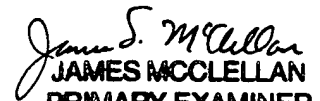
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on <sup>(571) 272-6788</sup> ~~703-308-5183~~. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

*ju*  
4/15/05

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mtot  
April 15, 2005

  
JAMES MCCLELLAN  
PRIMARY EXAMINER  
4/15/05